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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,243	08/28/2001	Geoffrey B. Rhoads	P0423	6983
23735	7590	01/28/2004		
DIGIMARC CORPORATION 19801 SW 72ND AVENUE SUITE 100 TUALATIN, OR 97062				
			EXAMINER VU, VIET DUY	
			ART UNIT 2154	PAPER NUMBER 17

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/941,243		<b>Applicant(s)</b> RHOADS, GEOFFREY B.	
	<b>Examiner</b> Viet Vu		<b>Art Unit</b> 2154	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on 22 December 2003.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 7-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) 16-18 and 22-31 is/are allowed.

6) ☐ Claim(s) 7-15 and 19-21 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

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**Art Rejections:**

1. The texts of 35 U.S.C. § 103(a) cited in the previous office action are hereby incorporated by reference.

2. Claims 7-15 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tow, U.S. pat. No. 5,315,098, hereafter '098, in view of Tow, European patent application No. 493,091, hereafter '091.

The patent '098 discloses a system and method for embedding digital data onto a printed halftone image comprising:

- a) receiving data corresponding to a graphic image (see col 3, lines 25-47),
- b) steganographically encoding the image to hide digital data, (see col 5, lines 10-31),
- c) producing/printing the image on physical medium for distributing to user who can decode the embedded digital data for use with an application, e.g., email (see col 1, lines 52-65).

The patent '098 does not explicitly teach embedding a network address. The patent application '091 teaches embedding onto a printed image many different types of digital binary codes including a hyperlink pointer, i.e. a network address (see col 4, lines 51-57).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the patent '098 to hide any known digital data in a printed halftone image including a network address. The use of a network address would have enabled the recipient to establish a communication link in the network, e.g., Internet.

Per claims 11 and 20-21, neither references teach accessing a remote data structure to obtain a network address. An official notice is taken that the use of a domain name server (DNS) to resolve network addresses in the Internet is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a conventional DNS in Tow because it would have enabled resolving a network address.

Per claim 15, it would have been further obvious to one of ordinary skill in the art to embed digital data onto a color image (see '091's col 1, lines 14-25).

**Allowable Subject Matter:**

6. Claims 16-18 and 22-31 are allowed over prior art of record.

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**Response to Amendment:**

7. Applicant's arguments filed on 12/22/03 with respect to claims 7-15 and 19-21 have been fully considered but they are moot in view of new grounds of rejection set forth above.

**Conclusion:**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on (703) 305-8498. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



VIET D. VU  
PRIMARY EXAMINER

V. Vu  
1/20/04